

REMARKS

Claims 2-27, 31-42, 44-51, 53-58, 60-78, 81-95, 101-103, 105-107 and 109-114 are currently pending, although claims 53-57, 60 and 61 have been withdrawn from consideration. Because the withdrawn claims ultimately depend from non-withdrawn claims, Applicant currently intends to seek rejoinder of the withdrawn claims pursuant to MPEP § 821.04 upon indication of allowable subject matter.

The Office Action rejected the pending claims under 35 U.S.C. §103 as obvious over EP 0548694 ("Nojima") in view of U.S. patent 5,738,841 ("Mellul") alone or in combination with U.S. patent 5,690,918 ("Jacks") or JP 63119412 ("JP 412"). In making these rejections, the Office Action asserted that "there is no evidence of record that the prior art alkoxyated silicones are non-volatile." (Page 8).

The Office Action also rejected the pending claims under 35 U.S.C. §103 as obvious over U.S. patent 5,800,816 ("Brieva").

In view of the following remarks, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Nojima requires the presence of alkoxyated silicone compounds. The amount of alkoxylation in Nojima's silicone compounds is "from 1 to 50% by weight, preferably from 5 to 40% by weight." (Page 3, lines 49-50. See also, page 4, lines 21-24). As explained in the Rule 132 declaration submitted concurrently herewith, such alkoxyated silicone compounds are non-volatile. Thus, Nojima requires the presence of an alkoxyated, non-volatile silicone compound.

In sharp contrast, all of the pending claims exclude the presence of such alkoxyated, non-volatile silicone compounds. That is, by virtue of (1) the language in the present claims requiring the non-volatile silicone component to "consist of" the

specified non-volatile silicone compounds, meaning that the only non-volatile silicone compounds which may be present in the claimed compositions are those identified in the claims; and (2) the fact that the specified non-volatile silicone compounds do not include alkoxyated silicone compounds, the claims require the presence of a non-volatile silicone component which does not include alkoxyated silicone compounds. Because Nojima requires the presence of alkoxyated, non-volatile silicone compounds, Nojima cannot teach or suggest the claimed silicone component, meaning that Nojima cannot teach or suggest the claimed invention.

This is particularly true for claims 113 and 114 which expressly prohibit the presence of alkoxyated silicone compounds in the claimed compositions.

Mellul cannot compensate for Nojima's deficiencies. For example, the combination of Nojima with Mellul would necessarily result in a composition containing an alkoxyated, non-volatile silicone compound given Nojima's teachings. In sharp contrast, all of the pending claims exclude the presence of such alkoxyated, non-volatile silicone compounds. For at least this reason, the combination of Nojima and Mellul does not set forth a *prima facie* case of obviousness.

Furthermore, Mellul provides no motivation to modify Nojima's compositions to yield the invention compositions. As noted above, Nojima requires the presence of alkoxyated, non-volatile silicones. Mellul, on the other hand, is directed to "surprisingly" homogenous mixtures of octyldodecyl neopentanoate and "at least one silicone-containing compound which may be chosen from silicone oils, gums and/or waxes." (Col. 2, lines 48-49). Mellul neither teaches nor suggests that her silicones could be alkoxyated and, in fact, teaches away from such alkoxyated silicones by identifying only non-alkoxyated silicones as being suitable for combination with

octyldodecyl neopentanoate. (Col. 2, line 49 through col. 3, line 6). One skilled in the art, following the teachings of both of these references, would not have been motivated to combine them given the highly specific nature of their disclosures: Nojima relates only to alkoxyated, non-volatile silicones, while Mellul relates to “surprisingly” homogeneous compositions containing non-alkoxyated silicones. Given the specificity of their disclosures, nothing in either of these references would have suggested that only non-alkoxyated silicones could be used in Nojima’s compositions or that only alkoxyated silicones could be used in Mellul’s compositions to yield a “surprisingly” homogeneous composition.

Also, Mellul does not relate to transfer-resistant compositions, let alone transfer-resistant lipsticks. Rather, Mellul discloses non-transfer-resistant compositions containing 0% inert particulate phase or 48% or more inert particulate phase,¹ and teaches that volatile silicone oils are interchangeable with non-volatile silicone compounds. (See, col. 2, line 51). One skilled in the art, seeking to produce a composition addressing appearance and sensation problems associated with transfer-resistant compositions, particularly lipsticks, would not be motivated by Mellul to selectively combine the required ingredients in the required proportions with the expectation that the resulting composition would be a transfer-resistant composition, particularly a transfer-resistant composition having desirable properties such as not having a matte appearance or a sensation of dryness, tautness and/or discomfort.

¹ In this regard, Applicant notes that pigments do not constitute fillers/inert particulate phase. (See, specification at pages 20 and 21; Mellul at col. 2, line 43).

Neither Jacks nor JP 412 suggests modifying Nojima's compositions to yield the claimed invention.

Regarding Jacks, as previously discussed (see, for example, Applicant's response filed November 16, 2005), Jacks relates to transfer-resistant compositions, and typically in such compositions volatile oil evaporates after application to form a transfer-resistant film. Jacks recognizes this crucial role of volatile oils in his transfer-resistant compositions, stating that volatile oils contribute to the "wear characteristics" of his compositions. (Col. 4, lines 10-11). This is presumably why Jacks teaches and exemplifies that substantial amounts of volatile oil should be present in his compositions, most preferably between 40-50%. (Col. 4, line 38).

One of the practical differences between the claimed invention and Jacks is that the claimed invention permits formation of a transfer-resistant film using a composition containing little or no volatile oil, whereas Jacks requires the presence of a substantial amount of volatile oil. One skilled in the art, seeking to create a transfer-resistant film, would not be motivated by Jacks to remove or reduce volatile solvent because removing volatile solvent would affect the wear-characteristics of these transfer-resistant products. In other words, Jacks would lead one skilled in the art away from the claimed invention.

JP 412, which is cited merely for its disclosure relating to 12-hydroxystearic acids, cannot compensate for Nojima's deficiencies as well.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 based upon Nojima, Mellul, Jacks and JP 412.

Regarding the § 103 based upon Brieva, Brieva (like Jacks) relates to a transfer-resistant composition. (See, for example, abstract). Brieva forms his transfer-resistant film upon application by incorporating trimethylsiloxysilicate (MQ resin) into his compositions. However, Brieva (like Jacks) uses a substantial amount of volatile oil, and the evaporation of such oil, to form his desired transfer-resistant film. This can be seen in all of the exemplified compositions in Brieva which contain much greater than 5% volatile oil. Thus, Brieva (like Jacks) relates to conventional transfer-resistant products, forming a transfer-resistant film through evaporation of significant amounts of volatile oil.

Nowhere does Brieva teach or suggest using trimethylsiloxysilicate in a composition containing 0-5% volatile oil to form a transfer-resistant film. That is, nowhere does Brieva provide sufficient guidance to one skilled in the art regarding how to form a transfer-resistant film upon application without using a substantial amount of volatile oil.

Merely because Brieva states that 0.1-60% volatile oil can be used in his compositions does not mean that Brieva adequately teaches one skilled in the art how to produce a transfer-resistant composition containing as little as 0.1% volatile oil. To the contrary, Brieva does not teach or suggest to one skilled in the art how to form a transfer-resistant film without using a substantial amount of volatile oil. Which non-volatile oils should be used to produce a transfer-resistant composition? Can any non-volatile oils be used? Brieva does not answer these questions. How much of such non-volatile oils should be added? Again, Brieva does not provide adequate guidance. How much, and what type of, particulate phase should be added. Once again, Brieva's disclosure is inadequate to answer these questions.

In stark contrast, the claimed invention enables one skilled in the art to produce a transfer-resistant product without using a significant amount of volatile oil through a unique combination of ingredients. Brieva does not contain a sufficiently detailed disclosure which would lead one skilled in the art to the particular constitution of the invention compositions, nor does it contain a sufficient disclosure to suggest that such a composition, lacking substantial amounts of volatile oils, would be transfer-resistant.

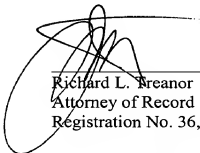
It is only through hindsight, using the disclosure of the present application as a guide, that Brieva's broad general disclosure can be twisted in such a way as to suggest the claimed transfer-resistant compositions containing minimal amounts of volatile oil. Such hindsight analysis is improper, and cannot render the claimed invention obvious.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 based upon Brieva.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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